

Appl. No.: 09/441,204
Amdt. dated April 6, 2004
Reply to Office action of January 15, 2004

REMARKS

The Office Action of January 15, 2004, has been reviewed, and in view of the foregoing amendments and following remarks, reconsideration and allowance of all of the claims pending in the application are respectfully requested. Despite disagreement with conclusions drawn in the Office Action, Applicants have submitted claim amendments that further define the inventions as originally disclosed in the above-referenced patent application that will further expedite prosecution. No new matter has been added.

New Claims

New claims 31-36 have been added. Claims 31 and 34 recite “wherein the resellers comprise distributors and the vendors comprise suppliers” This limitation is supported by at least page 5, lines 6-7. Claims 32 and 35 recite “an artwork library for storing artwork associated with at least one of the plurality of products.” This limitation is supported by at least page 5, lines 11-14. Claims 33 and 36 recite “wherein the at least one order is tracked and order status data is provided.” This limitation is supported by at least page 5, lines 15-17. No new matter has been added.

Specification

The Office Action alleges that page 14 of the Specification is missing. Applicants submit the postcard returned upon filing indicating that all 14 pages of the specification were originally filed, including page 14, as shown as Attachment A. For the convenience of the Examiner, a true

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copy of page 14 is attached as Attachment B. Applicants submit that the missing page 14 was due to mishandling at the Patent Office during prosecution.

A minor spelling error has been corrected through this amendment. In particular, “Arkwork” has been changed to “Artwork” on page 13, line 9 of the original specification. No new matter has been added.

Drawings

Figure 1 has been amended to include “Prior Art” label.

Replacement Drawings

Replacement Drawings are being submitted concurrently with this response as Attachment C.

Claim Rejections - 35 U.S.C. § 112

The Office Action alleges that claims 10 and 21-25 are rejected as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. The Office Action alleges that the omitted elements are a) essential elements that define a system capable of electronically connecting the disparate elements and b) essential elements that define a system capable of electronically processing the information.

Claims 10 and 21 have been amended to clarify that the claimed elements (e.g., database, web pages, interfaces and modules) are interoperably connected. Further, claims 10 and 21 have been amended to include a “computer implemented system.” Applicant submits that the system of claims 10 and 21 define a system capable of electronically connected the elements.

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In response to the Office Action's allegation that essential elements that define a system capable of electronically processing information are omitted, Applicant believes that the elements of claims 10 and 21 clearly define a system capable of electronically processing information. More specifically, claim 10 recites a database, web pages, and modules for receiving data and processing that data, as defined by the claim elements. Further, claim 10 explicitly recites a processor. In addition, claim 21 recites a database, interfaces, modules for receiving data and processing that data, as defined by the claim elements. As understood within the field of computers, a module refers to a unit of software or hardware. Applicant submits that independent claims 10 and 21 clearly recite *a system capable of electronically connecting the elements and a system capable of electronically processing the information.*

Claim Rejections - 35 U.S.C. § 101

The Office Action alleges that claims 20 and 26-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant respectfully disagrees. Claims 20 and 26 have been amended to further clarify the inventions. As claims 27-30 are dependent on claim 26, these claims inherently contain all the limitations of claim 26. As amended, these method claims recite steps of producing something that is concrete, tangible and useful result.

Claim Rejections - 35 U.S.C. § 103

Claims 10 and 20 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Promomart** in view of **Lorge** further in view of **Bunn** and further in view of **Call** (U.S. Patent No. 5,913,210).

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Claims 21 and 23 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Promomart** in view of **Call**, further in view of **Busch**.

Claims 22 and 24 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Promomart**, **Call** and **Busch**, as applied to claim 21, further in view of **Business Wire** and further in view of **911gifts.com**.

Claim 25 is presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Promomart**, **Call** and **Busch**, as applied to claim 21, further in view of **Lorge**.

Claims 26 and 28 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Promomart** in view of **Busch**.

Claims 27 and 29 are presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Promomart** and **Busch**, as applied to claim 26, further in view of **Business Wire** and further in view of **911gifts.com**.

Claim 30 is presently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over **Promomart** and **Busch**, as applied to claim 26, further in view of **Lorge**.

For at least the reasons stated below, Applicant respectfully disagrees and believes the claims are patentable over the current rejections under 35 U.S.C. § 103(a).

According to an embodiment of the present inventions, a system and method provide for an exchange platform that offers scaling opportunities and economies not available in the traditional business model. An embodiment of the present invention provides a central real-time exchange for creating a community environment for various participants in the promotional products industry and providing services that establish a web presence for each member.

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An exemplary embodiment of the claimed inventions include a product database for storing data related to a plurality of products, the data including at least pricing data and imprinting data related to the plurality of products; *a vendor entry point interface* for enabling a vendor to enter at least one product data specifics to the product database, the at least one product data specifics comprising one or more of imprinting data, display data, accurate detailed pricing data and product placement data; *a vendor showcase module* for displaying product data and providing ordering access to one or more resellers *at a reseller entry point interface*, wherein *the vendor showcase module is customized for a particular vendor*; *a branded promotional products module* for providing a plurality of promotional products to one or more of customers and resellers and receiving at least one order for one or more promotional products; *a reseller showcase module* for displaying products selected by the reseller for resale to a reseller group of customers selected by the reseller where the reseller group of customers accesses the reseller showcase module *at a reseller customer entry point interface*; and *a company logo store module* for displaying products selected by the reseller for resale to a group of customers associated with a company, wherein *the company logo store module is customized for the company*.

None of the references cited in any combination meet the combination of claim limitations set forth by Applicant. More specifically, Applicant recites discrete separate entry points for different players (e.g., vendor, reseller, customer, etc.). For example, independent claims 21 and 26 recite *a vendor entry point interface*, *a reseller entry point interface*, and *a reseller customer entry point interface*. Independent claims 10 and 20 recite *a products web*

page, a reseller showcase web page, a vendor showcase web page. These claimed features alone are not found in any reference or any combination of references cited. In addition, the Office Action has failed to address these claim limitations. In the Office Action's discussion of the Promomart reference (see pages 6-7 and pages 10-11) there is no mention of the discrete entry points as claimed by Applicant. Further, none of the secondary references teach the discrete entry points. For at least these deficiencies, the rejections of the pending claims are improper and should be withdrawn.

In contrast to the claimed inventions, Promomart appears to disclose an online database shopping cart that is routed to a retailer where a consultant may be selected. By selecting a product category, Promomart appears to provide a list of vendors from which products matching the category may be purchased from. The resulting page, as shown on page 16 of Promomart, is merely a list of consultants from whom products may be purchase. Therefore, Promomart is more akin to a referral service. Promomart clearly fails to disclose discrete entry points for different participants, such as vendors, resellers, and customers. Rather, there is no distinction of different participants in Promomart and all users appear to enter and access Promomart in the same manner. Therefore, different participants are unable to manage and enter data specific to their roles, as provided by the system and method of the present inventions.

Clearly, Promomart falls short of meeting the claimed limitations. As Promomart is used in each and every rejection, Promomart is deficient in all the current rejections. The secondary references, in any combination, fail to make up the major deficiencies of Promomart. More specifically, Call fails to provide any disclosure related to the distinct entry points claimed by

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Applicant. Busch appears to be provide any teaching even remotely related to the distinct entry points claimed by Applicant. Similarly, Business Wire, 911gifts.com, Lorge and Bunn all fail to provide any teaching related to the distinct entry points claimed by Applicant. Therefore, the cited references in any combination fail to obviate the claimed inventions.

Even if the references could be combined, the resulting combination would nevertheless fail to teach the claimed invention. The proposed rejections are a classic example of hindsight reconstruction that is contrary to the law. Controlling Federal Circuit and Board precedent require that the Office Action set forth specific and particularized motivation for one of ordinary skill in the art to modify a primary reference to achieve a claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (“[t]o prevent a hindsight-based obviousness analysis, [the Federal Circuit has] clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine the references.”). Here, the Office Action combines four disparate references, each of which are directed to different goals, to allegedly yield independent claims 10 and 20. For independent claims 21, the Office Action combines three disparate references, each of which are directed to different goals, to allegedly yield the independent claims. For independent claims 26, the Office Action combines two disparate references, each of which are directed to different goals, to allegedly yield the independent claims. The Office Action has failed to set forth a *prima facie* case of obviousness for the independent claims. Additionally, it fails to establish a *prima facie* case of obviousness for the further modifications proposed to yield the dependent claims.

Specifically, when a primary reference is missing elements, the law of obviousness requires that the Office Action set forth some motivation why one of ordinary skill in the art would have been motivated to modify the primary reference in the exact manner proposed. *Ruiz*, 234 F.3d at 664. In other words, there must be some recognition that the primary reference has a problem and that the proposed modification will solve that exact problem. All of this motivation must come from the teachings of the prior art to avoid impermissible hindsight looking back at the time of the invention.

In the present case, the Office Action's justification for modifying the various references has absolutely nothing to do with the deficiencies of Promomart. To properly modify Promomart to correct for these major deficiencies, the Office Action has the burden to show some motivation why providing those elements would have overcome some perceived problem with the Promomart system. Any such motivation is completely lacking.

The Office Action fails to show any motivation as to why one of ordinary skill in the art would have been motivated to combine the various combination of references. The mere fact that at least eight separate disclosures can be combined or modified does not render the resultant combination or modification obvious unless there is a suggestion or motivation found somewhere in the prior art regarding the desirability of the combination or modification. *See* M.P.E.P § 2143.01; *see also In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); *In re Fritz*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

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art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The remaining claims depend ultimately from independent claims 21 and 26 and, as such, contain the features recited in claims 21 and 26. As discussed above, the proposed combinations fail to suggest or disclose each feature recited in claims 21 and 26 and, therefore, also fails to suggest or disclose at least these same features in the dependent claims 22-25, 27-30 and new claims 31-36. For at least this reason, Applicant respectfully submits that the rejections of claims 22-25 and 27-30 are improper and request that they be withdrawn.

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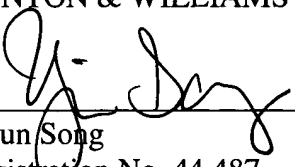
CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Response. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicants also authorize the Director to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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Dated: April 6, 2004

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ATTACHMENT A

UTILITY [X] DESIGN []

Application Serial No. To Be Assigned Client/Matter: 56490.000002

Inventor: David VERCHERE
Atty/Sec.: TJS/YS/rrl

Client: Corporate Gear LLC
Date: November 15, 1999
16

Title: Method and System for Acquiring Branded Promotional Products

**The following have been received in the U.S. Patent and Trademark Office
on the date stamped hereon:**

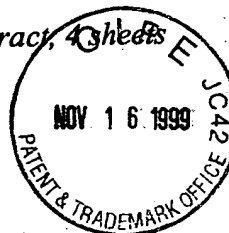
Transmittal (in duplicate)

***14 pages specification, 4 pages claims (1-20), 1 page Abstract, 4 sheets
formal dwgs. (1-4), executed Declaration***

Executed Verified Statement Claiming Small Entity Status

\$419.00 check

DOCKETED



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ATTACHMENT B

Microsoft SQL Server, Microsoft technologies Transaction server and Message queue as data layer servers.

Other embodiments and uses of the invention will be apparent to those skilled in the art from consideration of the specification and practice of the invention disclosed herein. The

5 specification and examples should be considered exemplary only.